

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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MAILED

JUN 28 2007

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte ADAM S. WYSZYNSKI

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Application 08/579,072

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on May 29, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Affirmed-in-Part decision<sup>1</sup> was rendered by the Board of Patent Appeals and

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<sup>1</sup> Claims 1-5, 7-11, 13, 15-18, 20 and 21 under 35 U.S.C. § 103 were sustained; claims 6, 12, 14 and 19 under 35 U.S.C. § 103 were not sustained.

Interferences (BPAI) on September 22, 2003. On November 21, 2003, a Request for Rehearing was filed. The Request for Rehearing was granted on January 20, 2004 “by designating our affirmance of the rejection of claims 1-5, 7-11, 13, 15-18, 20 and 21 as a new ground of rejection under 37 C.F.R. 1.196(b)” [page 3]. In addition, the case was remanded to the examiner “with respect to the patentability of claims 1 and 7 and the claims dependent therefrom” [page 3]. On April 14, 2005, the examiner responded to the remand by the BPAI. However, no period for response was designated. A Status Inquiry was filed by appellant on January 18, 2006.

On March 1, 2006, an Office communication was mailed which stated:

The Board of Appeals and Interferences responded to the Req. for Rehearing on Jan. 20, 2004 and designated the affirmance as a new ground[] of rejection. In the “Response to Remand” examiner is maintaining the rejection (please see attached “Response to Remand”<sup>2</sup>).

The examiner gave appellant one month or thirty days, whichever is longer, from the mailing of this letter to respond and stated that an extension of time under 37 CFR 1.136 will not be granted. Appellant timely filed a Reply Brief on March 31, 2006. A Status Inquiry was filed on June 29, 2006. On

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<sup>2</sup> Copy of original correspondence mailed April 14, 2005.

January 19, 2007, a PTO-90C was mailed stating that “[t]he Reply Brief filed 3/31/06 has been noted and entered in the file.”

It is noted that examiner should have stated that the new ground of rejection made by the BPAI in the decision on the Request for Rehearing mailed January 18, 2006 was made final, according to MPEP § 1214.01. Appellant would then need to file a new Notice of Appeal under 37 CFR § 41.31 followed by a new Appeal Brief under 37 CFR § 41.37.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to clearly state that the new ground of rejection made by the BPAI in the decision on the Request for Rehearing mailed January 18, 2006 and maintained by the examiner in his response mailed April 14, 2005 is made final;
- 2) for notification to appellant to file a new Notice of Appeal and Appeal Brief in response to the Final Action; and,
- 3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By: Patrick J. Nolan  
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